

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Art Unit 2625

Rodriguez et al.

Confirmation No. 5733

Application No.: 10/723,181

Filed: November 26, 2003

For: AUTOMATED METHODS FOR
DISTINGUISHING COPIES FROM
ORIGINAL PRINTED OBJECTS

VIA ELECTRONIC FILING

Examiner: S. Kau

Date: April 20, 2009

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheets. (No more than 5 pages are provided.)

Date: April 20, 2009

Respectfully submitted,
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REASONS FOR REQUEST FOR PRE-APPEAL REVIEW

Sir:

Responsive to the final Office Action dated December 19, 2008, Applicant files herewith a notice of appeal, a request for pre-appeal brief review, and the following reasons for requesting the pre-appeal review.

Claims 1-4, 14-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 7,054,461 to Zeller et al. ("Zeller").

Claims 5, 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeller in view of US Patent Publication 2001-0030759 by Hayashi et al. ("Hayashi").

Claims 6-10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeller in view of in view of US Patent Publication 2004-0075869 by Hilton et al. ("Hilton").

Claim 1

Zeller is not prior art to claim 1

Claim 1 has priority to at least January 20, 1999, based on the claim of priority to 09/234,780 (the '780 application). The '780 application describes embodiments that correspond to the elements of claim 1 as set forth below.

The Final Action states:

"The examiner notices that all independent claims are related to the parent application, or the first application, 60/071,983, but not the second application or third application, e.g., 10/012,703 and 09/898,901, and 60/071,983 is patented on

10/21/2003, which is earlier than the pending application filing date, 11/26,2003. The pending application is **NOT** entitled to the benefit of the filing date of 01/20/1998 of the first application.”

In sum, the Office contends that independent claims are not entitled to priority because the applications in the priority chain allegedly lack a common inventor and do not satisfy the co-pendency requirement. The Office has mis-applied both of these requirements. Regarding a common inventor, a valid priority claim requires at least one common inventor in each application in the priority chain. The priority chain pertinent to this claim reads as follows:

“This patent application is also a continuation in part of 10/012,703, filed December 7, 2001, which is a continuation of 09/433,104, filed November 3, 1999 (now U.S. Patent No. 6,636,615), which is a continuation in part of 09/234,780, filed January 20, 1999 (now abandoned), which claims priority to 60/071,983, filed January 20, 1998.”

The parent provisional application 60/071,983 names Rhoads as an inventor, and the subsequent, intervening non-provisional applications (09/234,780, 09/433,104, and 10/012,703) name Rhoads and Gustafson. This patent application names inventors in addition to Rhoads and Gustafson because of their inventive contribution to certain dependent claims that have different priority claims. However, at least Rhoads is listed in each application in this particular part of the priority claim being relied upon for the independent claims. Therefore, the common inventor requirement (namely, Rhoads) is met for the independent claims.

Regarding the co-pendency requirement, Applicants stated in response to the last action how this requirement is met. In particular, priority is claimed to application 09/234,780 through application 10/012,703, filed December 7, 2001, and issued on 6/1/04 (6,744,906), and application 09/433,104, filed November 3, 1999, and issued on 10/23/2003. Parent application 09/433,104 was filed prior to the abandonment of 09/234,780. One can clearly see from these filing and issuance dates that the co-pendency requirement is met. In the Final Action, the Examiner suggests that the independent claims are not related to 10/012,703, but as shown here, they clearly are related to 10/012,703, and the same subject matter cited below in 09/234,780 is also in 10/012,703 and 09/433,104. There is support for the independent claims in these priority applications, which are linked by co-pendency at each step in the chain. Therefore, the co-pendency requirement is met.

It is not clear why the Office cited 09/898,901 in the above quoted remarks from the Final Action. The application at issue here has different priority claims, each relating to different chains of priority applications. The chain of priority that includes application 09/898,901, has been cited for its applicability to claim 3. 09/898,901 is co-pending with this application and has at least one co-inventor (Reed) with the application at issue. The specification of this application at page 1, line 15, includes the following priority claim separate from the priority claim including the ‘780 application: “This patent application is also a continuation in part of 09/898,901, filed July 2, 2001.” Therefore, 09/898,901 is a separate priority claim and provides a separate basis for priority, which in this case, is July 2, 2001. Zeller was filed after this priority date as well.

Returning now to the support in the ‘780 application, an example of the specification support for claim 1 in 09/234,780 is reproduced below. This same subject matter is also in 09/433,104, and 10/012,703, which include everything from the ‘780 application.

Example of Specification Support in Priority Application 09/234,780

A method for analyzing an image of a printed object to determine whether the printed image is a copy or an original (see, e.g., page 2, line 24 to page 3, line 16 of the ‘780 application), the method comprising:

determining whether a machine readable auxiliary signal is embedded in the image (**in the ‘780 application, the two watermarks are a form of machine readable auxiliary signal embedded in the image**), wherein the auxiliary signal is embedded at embedding locations using a set of two or more print structures that change in response to a copy operation (see, e.g., **embodiments at page 6, line 9 to page 13, line 13; specifically, fine and coarse grain embodiment at page 7, lines 10-23, pixel assignment embodiment at page 8, line 17 to page 9, line 14, and an embodiment where the two watermarks have different color transformations at page 10, line 1 to page 13, line 13**), the change causing a divergence or convergence of a characteristic of the print structures such that the machine readable signal becomes more or less detectable (see, e.g., page 2, line 24 to page 3, line 16 of the ‘780 application); and
based on evaluating the machine readable auxiliary signal, determining whether the printed object is a copy or an original (see, e.g., page 3, lines 1-3, page 4, lines 9-22, and page 6, lines 1-7 of the ‘780 application)

For the reasons provided above, Zeller is not prior art to claim 1.

Claim 2

As noted above, the '780 application teaches an embodiment in which two watermarks with colors that change differently in response to a copy operation are used to distinguish an original from a copy. Therefore, the '780 application supports claim 2, and Zeller is not prior art.

Claim 3

Claim 3 is patentable over Zeller because it has priority over Zeller on the basis of 09/898,901 as noted above.

Claim 4

Based on the Office's interpretation of these claims, priority application 09/433,104, filed November 3, 1999 (Now 6,636,615) provides support for this claim. See Col. 7, lines 15-30 and specifically, line 23.

Claims 14-17 and 19-21

Claims 14-15 are supported by the '780 specification. Therefore, Zeller is not prior art.

Claim 16 is likewise patentable over the cited references.

Claim 17, though different than claim 1, is patentable over the cited references for similar reasons as provided for claim 1.

Claims 20 and 21, though different than claims 1 and 15, are patentable over Zeller for similar reasons as provided for claims 1 and 15.

Claims 5, 11, 12 and 13

Hayashi has been combined with Zeller as allegedly teaching the elements of claims 5, 11, 12 and 13 that are missing from Zeller. Hayashi is unrelated to analysis of a printed object to determine whether it is a copy or an original. Therefore, it does not provide relevant teachings that are sufficiently related to be combinable with Zeller. Hayashi discusses the embedding of information in an image by creating positive and negative patches, which have a difference in the number of ink dots. While this difference is used to embed information, it is not used to create a difference in print structures in response to a copy operation as claimed, and is not used to determine the difference between a copy and original.

The rest of the cited teachings of Hayashi are similarly unrelated to the analysis of differences that occur in response to a copy operation, and thus, do not provide pertinent teachings that are reasonably combinable with Zeller.

Claims 6-10 and 18

Claims 6-10 are patentable over Zeller and Hilton because Hilton does not teach methods that employ changes in print structure characteristics to determine whether a printed object is a copy or an original as claimed. Hilton does not teach the elements of these claims that are missing from Zeller, and Hilton is not sufficiently related to Zeller so as to be reasonably combinable with it. In fact, the Office cites paragraph 39 of Hilton, which specifically states that in one implementation, “the requirement is to protect against falsification rather than copying.” In other words, Hilton’s symbology is used to carry binary data to prevent falsification, not to determine whether the document is a copy or an original as claimed.

Moreover, Hilton shows binary data carried in vertical and horizontal lines, respectively, but is silent with respect to line continuity as recited in claim 8. Claim 18 is patentable for similar reasons as claim 8.

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